

Since claim 1 explicitly defines the step of placing a petroleum pipeline below the surface of the ground in the median of an interstate highway (free-way), and since claim 1 was rejected as anticipated by the Colonial Pipeline Company document and Federal Highway Administration Program Guide (FHWA) document, the contents of these documents should be carefully examined. Upon examination of these documents, it is clear that neither disclose the step of placing a petroleum pipeline below the surface of the ground in the interstate median. Claim 1 further specifies that the petroleum pipeline extends throughout a major portion of the length of the interstate highway below the surface of the ground in the median from a refinery to a distribution center. Where, in the FHWA and Colonial Pipeline documents are these limitations shown? There is no disclosure in either of these documents showing these process steps.

“Anticipation requires that a prior art reference disclose every claim element as set forth in the claim”. Orthokinetics, Inc. v Safety Travel Chairs, Inc., 806 F 2d 1565, 1 USPQ 2d 1081 (Fed. Cir. 1986). The FHWA proposes using large diameter pipes or box culverts for exclusive utility use near the edge of the right-of-way in conjunction with other highway construction. This language does not place a petroleum pipeline below ground in the median of an interstate highway (freeway).

With respect to the Colonial Pipeline Company document, anticipation of claim 1 is based upon the Examiner’s interpretation of this document. The Examiner first contends that there is no specific length of the claimed pipeline defined in claim 1. It is then asserted that “with the length of underground pipe and all of the interstates traversing the US, the pipeline (Colonial Pipeline Company document) would definitely, extend below and immediately adjacent the highways for at least some finite length”. (Emphasis added).

Firstly, claim 1 does specify that the pipeline extends below ground in the median for a major portion of the length of an interstate highway from a refinery to a distribution center. The interstate highways are depicted in Fig. 1 of the drawings. These are interstate highways referred to in claim 1 and in the specification. Each interstate highway has a predetermined length or extent. A major portion of this length defines a linear dimension. For the purpose of the claimed invention this is sufficient specifically in terms of 35 USC 112.

The contention that the pipeline (Colonial Pipeline Company document) would definitely extend below and immediately adjacent the highways for at least some finite length is based on an inference purported drawn from the contents of the Colonial Pipeline Company document and apparently information known or believed by the Examiner. Applicant contends that this contention is neither definite nor supported by the Colonial Pipeline Company document. “If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the ground is not Section 102 anticipation but Section 103 obviousness.” Scripps Clinic and Research Foundation v Genetech, Inc., 927 F2d 1565 18 USPQ 2<sup>nd</sup> 1001, 18 USPQ 2<sup>nd</sup> 1896 (Fed. Cir. 1991).

Nor would the invention defined in claim 1 be obvious under 35 USC 103 in view of the Colonial Pipeline Company document. While applicant does not know when the Colonial Pipeline was constructed or laid, it was probably done before 1988. The FHWA document points out that utilities were not allowed on freeways until 1988, except for crossings. There is no evidence in the Colonial Pipeline Company document nor any other information relating to the Colonial Pipeline known to applicant which suggest placing the petroleum line in median of an interstate highway and extending longitudinally below ground for a major length of the interstate highway.

The alternative rejection of claim 1 under 35 USC 103 as obvious over the Colonial Pipeline Company document appears to require no suggestion or direction in any prior art to modify the Colonial Pipeline Company document as proposed in the rejection. The Colonial Pipeline Company document, nor any other prior art reference, does not disclose locating a petroleum pipeline below surface in an interstate highway median and extending pipeline longitudinally of the interstate highway median for a major length of the highway. The disclosures in the prior art references of record do not suggest making the changes proposed in this rejection under 35 USC 103.

The suggestion that one of ordinary skill in the art would place a pipeline longitudinally below ground in an interstate highway median is based on the assumption that since all petroleum pipelines extend from “point a” to “point b”, this conclusion encompasses and negates the non-obviousness of locating a petroleum pipeline in an

interstate highway median. Apparently no suggestion in the Colonial Pipeline Company document is thought to be needed in order to modify this disclosure.

This rejection of claim 1 under 35 USC 103 as obvious over the Colonial Pipeline Company document is a complete departure from the well-known law of obviousness established in the case authorities. “Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, ‘[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification,’” In re Laskowski, 871 F 2d 115, 10 USPQ 2d 1397 (Fed. Cir. 1989). Applicant contends that the rejection of claims 1 and 2 under 35 USC 102 and 35 USC 103 over the Colonial Pipeline Company document is erroneous.

Since the FHWA document does not disclose locating a petroleum pipeline in an interstate highway median as defined in claims 1 and 2, this reference document can not anticipate claims 1 and 2 under 35 USC 102.

With respect to claims 4-6, the FHWA document does not disclose locating a petroleum pipeline or energy product supply line in an interstate highway right-of-way and extending the supply line a major length of the interstate highway, the claims are not anticipated by the FHWA document. The FHWA states that the proposal locates lines adjacent the edge (not in the right-of-way) and does not extend the major length of such a highway. Accordingly, the FHWA document does not anticipate these claims.

Claims 4 and 6 were rejected under 35 USC 102 as being anticipated by the reference entitled “Building the Future-Proof Telco” by David Diamond. The Diamond reference does not disclose locating these supply lines in the interstate highway right-of-way. These supply lines are located along the highway but do not extend the major length of the interstate highway.

In view of these remarks, reconsideration of the rejection of the claims is respectfully requested and applicant further request an early notice of allowance.

Applicant has attached hereto as Exhibit A, a document prepared by applicant expressing applicant's view on an efficient fuel distribution for the United States. It is requested that this document be entered as part of this record.

Respectfully submitted,

By Herman H. Bains  
Herman H. Bains, Reg. No. 19,330  
6101 Tracy Avenue  
Minneapolis, Minnesota 55436  
Phone: 952-929-9362 Fax: 952-929-9362  
e-mail: [hlhbains@aol.com](mailto:hlhbains@aol.com)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Comm. for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on June 24, 2004.

Herman H. Bains  
Person signing